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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,199	03/20/2006	Pasquale Strasso	4017-40	4123
23117 7590 09/02/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER PLUMMER, ELIZABETH A				
ART UNIT 3635		PAPER NUMBER		
MAIL DATE 09/02/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/562,199

Applicant(s)

STRASSO, PASQUALE

Examiner

ELIZABETH A. PLUMMER

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-624)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 12/23/2005; 02/06/2006

DETAILED ACTION

Preliminary amendments to the specification received 12/23/2005 have been received and entered. Claims 35-68 are pending. This is a first Office action on the merits for application serial number 10/562,199 filed 03/201/2006.

Specification

1. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Claim Objections

2. Claims 38-41 45-48 objected to because of the following informalities:
- a. Claims 38, 39 and 45 use phrases that are not colloquial English. The phrase "said anchoring element are obtained in opposite portions" is confusing. For purposes of examination, the examiner assumes that the anchoring elements are positioned in opposite portions. Appropriate correction is required.

b. Claim 48 uses the phrase "said tank". There is a lack of antecedent basis for this phrase. For purposes of examination, the examiner assumes the phrase should read 'a tank'.

c. Claim 36 uses the phrase "said water container". There is a lack of antecedent basis for this phrase. For purposes of examination, the examiner assumes the phrase should read "said water tank".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 35-41 and 49-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 35 the language between the preamble and portions of the body of the claim are inconsistent. For example, the preamble of the claim 35 sets for the subcombination "apparatus ... suitable for covering a water tank"; however, line 5 of the claim recites the combination of an apparatus with a tank which sets forth a positive relationship between the tank and the apparatus and thus appears to claim a combination. Clarification is required. For purposes of examination, this claim is being treated as a combination.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 35-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Garrett (US Patent 6,926,241).

- a. Regarding claim 35, Garrett discloses an apparatus (Fig. 21,22; abstract) comprising a covering arrangement (paragraph 28) suitable for covering a water tank which can be mounted onto an external portion of a building (paragraph 83), said covering arrangement being made in the shape of an architectural component, wherein said apparatus further comprises an angular positing device (Fig. 1,21,22) so configured as to keep said tank in a substantially vertical position.
- b. Regarding claim 36, the water tank is a component of a solar panel system (paragraph 83).
- c. Regarding claims 37 and 44, said angular positioning device comprises a seat (Fig. 21,22) arranged for housing said tank therein, and an anchoring element (510,512) for anchoring to said external portion.
- d. Regarding claims 38 and 45, said seat and said anchoring element are positioned in opposite portions (top, bottom) of a positioning shell element (frame).
- e. Regarding claims 39 and 46, said seat is obtained in a first positioning shell element (top frame 518).

- f. Regarding claims 40 and 47, said anchoring element is obtained in a second positioning shell element (bottom frame) hinged (via 520) on said first positioning shell element.
- g. Regarding claims 41 and 48, said seat is shaped such that a longitudinal axis of a tank can be arranged vertically by rotating said first positioning shell element in relation to said second positioning shell element (Fig. 21,22).
- h. Regarding claim 42, Garrett discloses a covering arrangement (tarp paragraph 83) suitable for covering a component of an air-conditioning system that can be mounted onto an external portion of a building, said covering arrangement being made in the shape of an architectural component.
- i. Regarding claim 43, an angular positioning device (frames with hinge) keep said component in a substantially vertical position (Fig. 21,22).
- j. Regarding claim 49, said external portion comprises a roof (Fig. 21,22).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 50-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US Patent 6,926,241).
- a. Regarding claim 50-55, Garret discloses the invention as claimed except for how the covering decoratively appears. However, it would have been a

matter of obvious design choice to form the architectural component as any type of decorative design, including a chimney cap, skylight, attic skylight, veranda, balcony, column, arch, wall arrangement, wall arrangement with a window, wall arrangement with a grille, wall arrangement made of bricks or wall arrangement made of panels, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966).

b. Regarding claims 56-57, Garrett discloses the invention as claimed except for what material comprises the architectural component. However, it would have been a matter of obvious design choice to form panel sections out of a material that resists atmospheric agents such as glass fiber, A.B.S., polycarbonate, polystyrene or sheet metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

9. Claims 58- are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew (US Patent 3,742,659) in view of Cherkas et al. (US Patent 5,858,494).

a. Regarding claim 58, Drew discloses a method for a building wherein there is a functional non-architectural element with a cover (abstract; Fig. 1). Drew does not disclose that element is disguised by the method of reproducing a selected part of a building to get an image therefrom onto a layer element and

then applying said layer element onto a supporting element surrounding a functional non-architectural element. However, it is notoriously well known in the art that different items can be decorated. It is also notoriously well known in the art that a method of decorating an object can comprise reproducing a selected part of an original to get an image therefrom onto a layer element and then applying the layer element onto a support surface element. For example, Cherkas et al. discloses the method of decorating an object (lure) can comprise reproducing a selected part of an original (fish) to get an image therefrom onto a layer element and then applying the layer element onto a support surface element (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Drew to use the method of creating decorations, wherein the decorating of an object can comprise reproducing a selected part of an original to get an image therefrom onto a layer element and then applying the layer element onto a support surface element, such as taught by Cherkas et al., in order to better disguise and blend in the architectural element.

- b. Regarding claim 59, the supporting surface is part of a covering arrangement enclosing said functional non-architectural element (Fig. 1).
- c. Regarding claim 60, the supporting surface element is on an external surface of the functional non-architectural element (Fig. 1).
- d. Regarding claim 61, Cherkas et al. further discloses the image can be obtained using a photographic device (camera).

- e. Regarding claim 62, the image is transferred onto a supporting film, so as to form a covering layer (abstract).
 - f. Regarding claim 63, applying the covering layer can comprise winding the layer element around the covering arrange housing said functional non-architectural element.
 - g. Regarding claim 64, applying comprises inherently mutually engaging opposite edge of the layer element.
 - h. Regarding claim 65, while Drew in view of Cherkas et al. is silent as to the shape of the covering arrangement, it would have been a matter of obvious design choice to form the architectural component as any type of decorative design, including a chimney cap, skylight, attic skylight, veranda, balcony, column, arch, or wall arrangement, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966).
 - i. Regarding claim 68, the functional non-architectural element can be an air-conditioning system (column 1, lines 15-68).
10. Claims 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew (US Patent 3,742,659) in view of Cherkas et al. (US Patent 5,858,494 as applied to claim 58 above, and further in view of Garrett (US Patent 6,926,241).
- a. Regarding claims 66-67, Drew in view of Cherkas et al. discloses equipment can comprise the functional non-architectural element (column 1, lines

7-10). While Drew does not specifically state that the equipment can be a water tank in a solar panel system or an air-conditioning system, it is notoriously well known in the art that a type of equipment to be mounted and covered on a roof can include a water tank with a solar panel system. For example, Garrett discloses a water tank in a solar panel system (paragraph 83) can be housed in an apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Drew in view of Cherkas et al. to include a water tank in a solar panel system, such as taught by Garrett, in order to supply hot water to a building.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH A. PLUMMER whose telephone number is (571)272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeanette E Chapman/
Primary Examiner, Art Unit 3633

/E. A. P./

Examiner, Art Unit 3635